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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,616	10/30/2003	Paul Grady Russell	10013555-4	7342

7590 11/24/2004

HEWLETT-PACKARD COMPANY
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EXAMINER	
DURAND, PAUL R	

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,616	RUSSELL, PAUL GRADY	
	Examiner	Art Unit	
	Paul Durand	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/9/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 11,12-15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perbet et al (US 4,915,231) in view of Adams (GB 2 265 885).

In regard to claims 11 and 15, Perbet discloses the invention substantially as claimed including product 3, backing material 4, coated with synthetic material 6, which is encased by flexible plastic material 7 and 8 (see Figs.1-3 and C4,L4-29). What Perbet does not disclose is the use of an adhesive layer on the backing material to hold the objects. However, Adams teaches that it old and well known in the art of packaging to provide an adhesive layer (no number given, but indicated by dashes), that is applied to the packaging backing 10 and contacts objects for the purpose of holding the objects in a stationary position (see Figs. 4,6,15 and C8,L34-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced the pliable backing with synthetic material of Perbet with an adhesive layer as taught by Adams for the purpose of holding the objects in a stationary position.

In regard to claim 12 Perbet discloses the invention substantially as claimed including cardboard backing 4 that is rigid and can be recycled (see C4,L7-9).

In regard to claims 13 and 14, Perbet and Adams disclose the invention substantially as claimed including an adhesive surface. However, Perbet does not specifically disclose the type of adhesive used. However, the examiner takes Official Notice that it is old and well known in the art of packaging to provide an adhesive that can be comprised of a holt melt type or a non permanent glue for the purpose of bonding a product and wrapper without causing damage to the product during removal. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Perbet with packaging adhesive comprised of a holt melt type or a non permanent glue for the purpose of bonding a product and wrapper without causing damage to the product during removal.

In regard to claims 18-20, Perbet discloses the invention substantially as claimed including synthetic wrappers. However, Perbet does not specifically disclose the specific transparency of the material. However, the examiner takes Official Notice that it is old and well known in the art of packaging to provide packaging material film with a transparent, opaque or a combination of both for the purpose of enhancing the look of the product package. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Perbet with packaging comprised of various levels of transparency for the purpose of enhancing the look of the product package.

3. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perbet et al in view Adams as applied to claim 11 and in further view of Saindon et al (US 5,518,559).

Perbet discloses the invention substantially as claimed including except for the use of registration marks and indicia on the package. However, Saindon teaches that it is old and well known in the art of packaging to provide a film 11 with registration marks 100 and marketing information indicia 101 for the purpose of correctly packaging and displaying an item (see Fig. 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Perbet with the registration marks and indicia as taught by Saindon for the purpose of correctly packaging and displaying an item.

Response to Arguments

4. The newly submitted abstract filed with the response on 8/9/2004 is accepted.

5. Applicant's arguments filed 8/9/2004 have been fully considered but they are not persuasive.

Applicant's first argues that there is no suggestion to combine the references of Perbet and Adams since the reference of Perbet does not require an adhesive and the teaching of Adams uses a heat activated adhesive. The examiner does not agree, and examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Perbet discloses the

invention including the use of skin packaging. The skin packaging suggests some motivation to immobilize that part after it has been packaged, while preventing tampering . Furthermore, the teaching of Adams also wished to immobilize the product being packaged and uses an adhesive. The examiner contends that there is sufficient motivation to combine the references. Furthermore, while the teaching the Adams discloses the use of a heat-activated adhesive, the examiner contends that in the broadest reasonable interpretation of the applicant's claims, the adhesive does in fact read on them.

Applicant further argues that the teaching of Saindon is non-analogous art since it does not teach of the packaging methods cited in the prior rejected references. While the examiner does agree that the reference does not teach the use of the packaging means cited, the examiner contends that the reference was supplied to show applicant the that it is well known in the art of packaging to provide registration marks and company information on a package.

Therefore, for the reasons indicated above, the rejection is deemed proper.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EUGENE KIM
PRIMARY EXAMINER

Paul Durand
November 17, 2004